

REMARKS**NEW MATTER REJECTION**

By disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant necessarily discloses that function, theory or advantage even though he says nothing concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *See In re Smythe, 178 USPQ 279, 285 (C.C.P.A. 1973)*

The practical, legitimate inquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit "new matter," 35 U.S.C. 132, Rule 118, for the simple reason that what is originally disclosed cannot be "new matter" within the meaning of this law. If the drawing, then, contains the necessary disclosure, it can "form the basis of a valid claim." *See In re Wolfensperger, 302 F.2d 950, 133 USPQ 537, 542 (C.C.P.A. 1962)*

It is well settled that the specification of an application may be corrected or implemented by matter contained in an original claim, and that such matter may form as much a part of the disclosure of an application as if it had appeared in the body of the specification. *See Bocciarelli v. Huffman, 232 F.2d 647, 109 USPQ 385, 388 (C.C.P.A. 1956).*

Here, regarding claim 8 and 20, as noted in the prior response, pressure points were disclosed in the claims. Pressure points have a specific function as noted in the

article provided. Thus, the specification can be amended to support the claims. As noted above, this is not considered new matter. Additionally, the Figures show the plurality of pressure points along the back layer. One skilled in the art can see the pockets of foam along the back area in the figures. Thus, the specifications can be amended to support the drawings. This should not be considered new matter.

112 REJECTIONS

Examiner noted that claims 1-6 and 8-23 were rejected as being indefinite under 35

USC Section 112. The changes recommended by examiner were made for clarification only. Regarding claim 1, members was changed to member. Regarding claim 2, the was deleted. Regarding claim 6, is was inserted after layer. Regarding claim 14, the inner surface was changed to an inner surface. Regarding claim 15, the outer peripheral edge was changed to an outer peripheral edge. Regarding claim 19, "is" was inserted after layer.

Regarding claim 8 and 20, in the prior amendment, Applicant provided definition of pressure points because Examiner stated it was unclear in Claim 7. Applicant made appropriate amendments for clarification. Applicant added its definition of pressure points. Because pressure points were defined in the original claims, as noted by above case law, the functional definition can be added and not be considered new matter. Additionally, FIG. 4, shows a plurality of pressure points. Thus, there is adequate disclosure in the original specifications to allow the clarification of pressure points and not be considered new matter. In one embodiment the inner layer foam of the back area is continuous and in the other embodiment the back consists of small pockets of foam pressure points as shown in FIG. 4. There is a difference between regular foam and memory foam. The memory foam is not normally used in manufacturing of clothing.

The memory foam is used in mattresses. Thus, one skilled in the art would not choose this type of foam.

CONDITION FOR ALLOWANCE.

It is not clear what needs to be done to place this application in a condition for allowance. Examiner states that if I clear up 1 and 14 it would be allowable. Applicant made changes for claim 1 and 14 to place application in a condition for allowance. However, claim 18 is stated to be allowable on the cover sheet. Applicant placed claim 18 within claim 14 to place application in a condition for allowance. If this is not required examiner needs to call applicant with appropriate corrections. Applicant amended inner layer to back portion in claim 8 and 20 to place the application in a condition for allowance. Applicant reiterates arguments for 102 and 103 rejections below. Applicant will place a call to discuss the issues to place this application in a condition for allowance.

102 REJECTIONS

Examiner noted that claims 1, 2, 7, 12-15, 22, and 23 were rejected under USC Section 102 by **Witkower**. The reference must describe every detail of the claimed invention. (See **Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed Cir. 1983)). Additionally, the reference must adequately describe the claimed invention to put it in the public domain (See **In re Zenitz**, 333 F.2d 924, 142 USPQ 158, 160 (C.C.P.A. 1964)). The description must enable a person with ordinary skill in the art not only to comprehend the invention but also make it. (See **Paperless Accounting, Inc v. Bay Area Rapid Transit Sys.**, 804 F.2d at 665, 231 USPQ at 653) The reference must teach the claimed invention. (See **Ex parte Fujshiro**, 199 USPQ 36 (Pat. Off Bd. App. 1977)).

Here, in claim 1 the applicant claims support members covering at least the lower section of each breast cup, and is made of a strong rigid material and semi-circular in shape. In claim 5, the back portion is continuous. The hook and eye to fasten the breast

cups is along the inner peripheral edge of the mid-section which secures the entire breast support apparatus around the wearer's upper back area.

Witkower discloses crescent shape support members attached to the inner surface areas of each breast cup as viewed FIG. 1 and 2. As viewed each support member is vertically attached along the internal peripheral edge of each mid-section. The back portion is not continuous. The cup members are attached by a hook and eye, but these fasteners does not secure the breast support apparatus in place as disclosed by the applicant. The type of material used for the support member is not disclosed. In Witkower, a hook and eye fastened to each end of the separated back portion securely fastens the breast support apparatus in place.

Thus, Witkower does not disclose each and every claim limitation as claimed by the applicant and does not anticipate the claimed invention.

103 REJECTIONS

Examiner noted that claims 3-6, 16, 17 were rejected under USC section 103 by Witkower in view of Chen.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination (See *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990))

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination (See *In re Geiger*, 815 F.2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987)).

There must be some reason given the prior art why one of ordinary skill in the art would have been prompted to combine the teachings of the references to arrive at the claimed invention. (See *In re Regel* 188 USPQ

References that teach away cannot serve to create a prima facie case of obviousness. (See *In re Gurl;ey*, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir. 1994)) In If references taken in combination would produce a “seemingly inoperative device”, we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness. (See *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244)

Obvious to try standard is an improper standard (See *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (C.C.P.A. 1967)) It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. An obvious rejection cannot be based upon hindsight and the specific teaching must come from the prior art. (See *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 178, 1784 (Fed. Cir. 1992). The claimed invention must be considered as a whole.

Examiner's may not use as an element of the obvious rejection that one skill in the art would arrive at the invention trying different alternative structures or materials (See *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (C.C.P.A. 1967) that which is within the capability of one skilled in the art is not synonymous with obvious. *Levengood* teaches that an obvious rejection cannot be predicated on the fact that one skilled in the art would have the capability to arrive at the invention. Thus, that one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound reasoning does not afford the basis for an obvious conclusion (See *Id.*, 123USPQ at 352).

Here, in claim 1 the applicant claims support members covering at least the lower section of each breast cup, and is made of a strong rigid material and semi-circular in shape. A hook and eye fastens the breast cups along the inner peripheral edge of the mid-section securing the breast support apparatus in place. In claim 5, the back portion is continuous.

Witkower discloses crescent shape support members attached to the inner surface areas of each breast cup as viewed FIG. 1 and 2. As viewed each support member is vertically attached along the internal peripheral edge of each mid-section of each breast cup. The cup members are attached by a hook and eye, but these fasteners does not secure the breast support apparatus in place. In Witkower, a hook and eye fastened to each end of the separated back portion securely fastens the breast support apparatus in place.

Here, additionally, the applicant claims in several claims including claim 8 foam or memory foam that molds to the shape of the body. See exhibit 1. Applicant amended application to define memory foam. Chen discloses only flexible foam which means a foam (i.e. rubber or plastic material filled with many small bubbles of air to make it soft and light) material that bends in any direction.

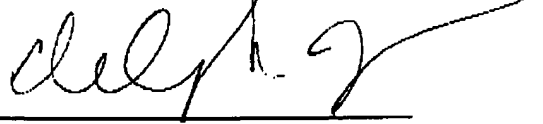
Witkower in view of Chen discloses a different structure than what is claimed by the applicant. Thus, Witkower in view of Chen does not suggest or teach the applicant claimed structure.

CONDITION FOR ALLOWANCE

Claim 18 was withdrawn and moved into claim 14 to place application in a condition for allowance. Claim 8

Applicant respectfully requests that the rejections be withdrawn. Alternately should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he/she is invited to telephone the undersigned.

Respectfully submitted:



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CERTIFICATE OF TRANSMISSION

I, Delphine James, hereby certify that the foregoing Response to the Office
Action is being transmitted to the Commissioner of Patents on ~~August 8, 2004~~ ^{5/1/2006}.

Facsimile phone number is 571-273-8300.

**COMMISSIONER OF PATENTS
PO BOX 1450
ALEXANDRIA, VA 22313-1450**

BY: 

Delphine James

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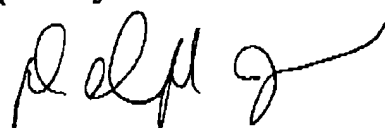
Witkower discloses crescent shape support members attached to the inner surface areas of each breast cup as viewed FIG. 1 and 2. As viewed each support member is vertically attached along the internal peripheral edge of each mid-section of each breast cup. The cup members are attached by a hook and eye, but these fasteners does not secure the breast support apparatus in place. In Witkower, a hook and eye fastened to each end of the separated back portion securely fastens the breast support apparatus in place.

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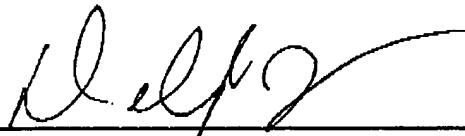
CERTIFICATE OF TRANSMISSION

I, Delphine James, hereby certify that the foregoing Response to the Office

Action is being transmitted to the Commissioner of Patents on May 1, 2006.

Facsimile phone number is 571-273-8300.

**COMMISSIONER OF PATENTS
PO BOX 1450
ALEXANDRIA, VA 22313-1450**

BY: 

Delphine James

Office Action Summary

10/732,707

WOOTEN, ANDREA

Examiner

Art Unit

Gloria Hale

3765

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

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Status

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- 1) ☒ Responsive to communication(s) filed on 8-8-05 Amendment.
 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-23 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-6, 8, 12-17, 22 and 23 is/are rejected.
 7) ☒ Claim(s) 9, 11 and 18-23 is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

*x As noted in
manuscript in
file - is not
used in garment
Manny - and in
not in use.*

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 08 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
 5) ☐ Notice of Informal Patent Application (PTO-152)
 6) ☐ Other: _____

U.S. Patent and Trademark Office
PTOL-326 (Rev. 7-05)

Office Action Summary

Part of Paper No./Mail Date 200512

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Application/Control Number: 10/732,707

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Art Unit: 3765

aesthetically pleasing appearance. Accordingly it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cup of Witkower to include foam in a breast cup for a smooth appearance and comfort to the wearer. (See Chen, col. 2, line 22). Chen also does not specifically disclose the use of memory, viscoelastic foam. *Not well known in the art. Also in many other garment manufacturing* Such foams are well known in garment manufacturing for their smooth appearance and cushioning structure. The substitution of different foam materials for each other is well known such as is acknowledged in applicant's *in several types of foam.* specification on page 4 where it is stated that viscoelastic or any other suitable foam can be used. NO criticality was given for the use of a specific type of foam over another such as the use of the viscoelastic foam over any other type of foam. One of ordinary skill in the art would have had the ability to select any desired foam material, such as a viscoelastic foam, in order to achieve the benefits of that foam material within the brassiere of Witkower. Such a selection would have been done in order to achieve a desired aesthetic effect or level of comfort to the wearer. Such a selection would have been a matter of design choice. It is well known that the selection of known materials in order to achieve a known benefit of that material within a finished product is within the skill of one of ordinary skill in the art as a selection of a known material as design expedient of one of ordinary skill in the art. In re Leshin 125 USPQ 416.

Claims 1 and 14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.